

Applicants : Butts, *et al.*
Appl. No. : 10/614,537
Examiner : Hussein A. El Chanti
Docket No. : 700693-4022

REMARKS

Claims 1-29 are pending in the present application.

Claims 1-4 and 6-29 have been rejected as being anticipated by U.S. Patent No. 6,574,239 to Dowling *et al.* (“Dowling”).

Claim 5 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Dowling in view of alleged knowledge in the art.

Claim 1 has been amended.

It is respectfully submitted that no new matter has been added.

Reconsideration of the application as amended herein is respectfully requested.

RESPONSE TO ARGUMENTS

The Office Action states that Applicant’s arguments in the previous response filed on September 23, 2008 are not persuasive because the recitation of “co-verification” occurs in the preamble, thus has not been given patentable weight. 12/09/2008, Final Office Action, p. 8, ¶ 4.

In response, Applicant respectfully submits that the determination of whether a preamble limits a claim is made on a case-by-case basis in light of the facts in each case. *Catalina Mktg. Int’l v. Coolsavings.com, Inc.*, 289 F.3d 801, 808, 62 USPQ2d 1781. MPEP § 2111.02. Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation. *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989). MPEP § 2111.02 (I). In light of this, claim 1 recites “[a] co-verification interface that ... is implemented in a design verification system” and “a physical layer [of the co-verification interface]... being configured to communicate with a second system element of the design verification system.” Emphasis added. These features of

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claim 1 require the claimed invention be implemented in and in communication with **“a design verification system,”** thus are considered as structural limitation of the **“co-verification interface”** that claim 1 claims. As discussed earlier, Dowling’s communication system is not a **“design verification”** nor can a teaching or suggestion to verify user’s design be found therein. See 09/23/2008, Applicant’s response, p. 13. Therefore, Applicant respectfully submits that the Examiner’s ground of rejection based on the assertion that the limitation of **“co-verification”** occurs only in the preamble, thus is not given patentable weight finds no basis and is inappropriate.

The determination of whether preamble recitations are structural limitations can be resolved only on review of the entirety of the application “to gain an understanding of what the inventors actually invented and intended to encompass by the claim.” *Pac-Tec Inc. v. Amerace Corp.*, 903 F.2d 796, 801, 14 USPQ2d 1871, 1876 (Fed. Cir. 1990). MPEP § 2111.02 (I). The **“co-verification interface”** of claim 1 **“is implemented in a design verification system”** and the **“physical layer”** of the **“co-verification interface”** **“communicate[s] with a second system element of the design verification system.”** These features of claim 1 is what Applicant claims and intends to encompass by the **“co-verification interface”** that claim 1 claim, thus are structural limitations of claim 1. For these reasons in addition to the reasons discussed below, Applicants respectfully submit that claim 1 and claims 2-20 that depend from claim 1 are not anticipated under 35 U.S.C. §102(b) by Dowling.

Claim 21 recites **“[a] co-verification interface implemented in a design verification system,”** **“a first application layer ... configured to communicate with the physical system element [of the design verification system]”** and **“a second application layer... configured to**

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communicate with the virtual system element [of the design verification system].” These features of claim 21 are not taught nor suggested by Dowling, therefore Applicants respectfully submit that claim 21 is not anticipated under 35 U.S.C. §102(b) by Dowling.

Claim 22 recites “[a] **design verification system**” and “**said first system element [of the design verification system]... configured to communicate with the second system element [of the design verification system].”** These features of claim 22 are not taught nor suggested by Dowling, therefore Applicants respectfully submit that claim 22 and claims 23-24 that depend from claim 22 are not anticipated under 35 U.S.C. §102(b) by Dowling.

Claim 25 recites “**coupling system elements of design verification systems**” and “**configuring said first plurality of communication connections to communicate with said first system element .”** These features of claim 25 are not taught nor suggested by Dowling, therefore Applicants respectfully submit that claim 25 and claims 26-29 that depend from claim 25 are not anticipated under 35 U.S.C. §102(b) by Dowling.

CLAIM REJECTIONS

Rejections under 35 U.S.C. §102(b)

The Office Action has rejected claims 1-4 and 6-29 under 35 U.S.C. §102(b) as being anticipated by Dowling. Applicant respectfully traverses this rejection.

Dowling discloses a method for reconnecting a telephone modem with a reduced delay by reducing a time associated with retraining. After a connection is terminated and then reestablished, the trained set of parameters for the connection is used to reconnect the model with a reduced set-up delay. See Dowling, Abstract. Dowling further discloses that the invention

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relates generally to client-server computing architectures and communication techniques. See Dowling, Col. 1, lines 7-8.

There are several fundamental differences between Dowling and the claimed subject matter. First of all, Dowling's system is directed to "a communication system including the remote unit and the virtual session server to support virtual sessions communications." See Dowling, Col. 3, lines 52-55. In contrast, claim 1 as amended requires "[a] **co-verification interface ... implemented in a design verification system.**" Emphasis added. Dowling's communication system is not a "design verification" nor can a teaching or suggestion to verify user's design be found therein. To anticipate a claim, the reference must teach every element of the claim. MPEP 2131. Since Dowling does not this feature of claim 1 requiring "[a] **co-verification interface ... implemented in a design verification system.**" Applicants respectfully submit claim 1 is not anticipated under 35 U.S.C. §102(b) by Dowling.

Furthermore, claim 1 as amended requires a "**co-verification interface that interfaces with either a physical system element or a virtual system element.**" This feature of claim 1 is neither taught nor suggested by Dowling. In fact, Dowling describes a communication system that only interfaces with a physical system element such as a remote unit or a server. See Dowling, Col. 3, lines 36-55. Therefore, Applicant respectfully submits that claim 1 not anticipated under 35 U.S.C. §102(b) by Dowling.

In addition, Dowling discloses that "a first protocol stack with an application session layer software module 151 communicates with a second protocol stack with an applications session layer software module 152." See Dowling, Col. 8, lines 36-39. Dowling further discloses that "the virtual session layer software module 154 communicates with a peer-to-peer

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communication path 182.” Col. 8, lines 56-59. Therefore, Dowling teaches that there are several communication channels (180, 182 and 184, Figure 2, Dowling) between the first system element (left side of Figure 1A) and the second system element (right side of Figure 1A).

In contrast, claim 1 as amended requires that “a physical layer ... [is] configured to **communicate with a second system element of the design verification system only via the communication system**.” Emphasis added. This feature of claim 1 is neither taught nor suggested by Dowling, therefore, Applicant respectfully submits that claim 1 not anticipated under 35 U.S.C. §102(b) by Dowling.

Claims 2-20 depend from and carry the limitations of claim 1, therefore claims 2-20 are not anticipated by under 35 U.S.C. §102(b) by Dowling.

Claim 21, as amended, requires that “**the physical system element and the virtual system element communicate only via the physical layer**.” Emphasis added. This requirement of claim 21 is neither taught nor suggested by Dowling for the reason discussed above, therefore Applicants respectfully submit that claim 21 is not anticipated under 35 U.S.C. §102(b) by Dowling.

Claims 22-29 have similar limitations as claims 1-21 as the Office Action admitted (3/24/08, Office Action, page 8), therefore Applicants respectfully submit that claims 22-29 are not anticipated under 35 U.S.C. §102(b) by Dowling for the reason discussed above.

Rejections under 35 U.S.C. §103(a)

The Office Action has rejected claim 5 under 35 U.S.C. §103(a) as being unpatentable over Dowling. Applicants respectfully traverse this rejection.

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In rejecting claim 5, the Examiner stated that “Dowling does not explicitly teach that the standard coupling interface comprises an Open Core Protocol. Official notice is taken that it would have been obvious for one of ordinary skill in the art at the time of the invention to implement open core protocol in Dowling’s interface.” 3/24/08, Office Action, page 9.

Whether or not one of ordinary skill in the art is motivated to implement Open Core Protocol in Dowling’s invention, claim 5 is not anticipated by Dowling because claim 1, from which claim 5 depends, is allowable over Dowling for the reasons discussed above. Therefore Applicants respectfully submit that claim 5 is patentable under 35 U.S.C. §103(a) over Dowling.

CONCLUSION

In view of the foregoing, it is believed that all claims now pending (1) are in proper form, (2) are neither obvious nor anticipated by the relied upon art of record, and (3) are in condition for allowance. A Notice of Allowance is earnestly solicited at the earliest possible date. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (650) 614-7660. If there are any additional charges, please charge Deposit Account No. 15-0665.

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Respectfully submitted,

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By: 

Jeffrey A. Miller
Reg. No. 35,287

Orrick, Herrington & Sutcliffe LLP
4 Park Plaza, Suite 1600
Irvine, CA 92614-2558
Telephone: 650 614-7660
Facsimile: 650 614-7401
Customer Number: 34313

OHS West:260621676.1
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